

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)
)
Roberto CAVAZZUTI et al.)
)
Application No.: Unassigned) Prior Group Art Unit: 1617 (parent)
)
Filed: February 27, 2004) Prior Examiner: E. Webman (parent)
)
For: METHOD OF MAKING A MASCARA)
COMPOSITION-COMPRISING)
POLYAMIDE POLYMER AND AT)
LEAST ONE SOLID SUBSTANCE)
HAVING A MELTING POINT OF 45°C)
OR GREATER (AS AMENDED)

Mail Stop Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

PETITION TO MAKE SPECIAL
UNDER 37 C.F.R. §1.102(d) AND M.P.E.P. § 708.02 (II)

In accordance with 37 C.F.R. §1.102(d), Applicants hereby petition the Commissioner of Patents and Trademarks to make this application special and receive accelerated examination. Applicants are enclosing a check for \$130.00 to cover the fee for this Petition as set forth in 37 C.F.R. § 1.17(h). If any additional fee is required in connection with the filing of this Petition, please charge that fee to our Deposit Account No. 06-0916.

As set forth in M.P.E.P. § 708.02 (II), an application may receive accelerated examination when there is an infringing device or product actually on the market or an

infringing method in use. The undersigned are aware of at least one product, having purchased a product sold under the trade name "MagnaScopic® Maximum Volume Mascara", currently in use as a mascara on the U.S. market. A copy of the packaging in which the MagnaScopic® product is sold is attached as Exhibit A.

The undersigned has performed a rigid comparison of the MagnaScopic® product and its intended use as a mascara with at least one claim of the present application as pending from the Preliminary Amendment filed concurrently herewith. Even though Exhibit A identifies the MagnaScopic® product as "Made in Canada," *i.e.*, outside the United States, the undersigned is of the opinion that at least one of the claims presented in the present application is unquestionably infringed, under 35 U.S.C. §271(g), by the production of the MagnaScopic® mascara product and the subsequent importation of that MagnaScopic® mascara product into the U.S. The claimed mascara composition is not a staple article of commerce and is used by consumers for the purpose intended by Estée Lauder's packaging, Exhibit A, and advertising, *i.e.*, as a mascara in a method of making up eyelashes. See Estée Lauder's webpage advertising the MagnaScopic® mascara product. See Exhibit B at page 1, available at <http://www.estelauder.com> (referring to the MagnaScopic® Maximum Volume mascara and instructing product users to "[s]weep MagnaScopic® through lashes from root to tip, using tapered end to capture the finest lashes at inner corners. Repeat on lower lashes" and stating "Magnify your lashes to the maximum - in a flash" and "Magnifies lashes up to 300% instantly"); *see also* Claim Chart attached as Exhibit C.

Applicants submit herewith an Information Disclosure Statement. The undersigned submits that, although no independent search has been conducted, the undersigned has a good knowledge of the pertinent prior art, in part because the

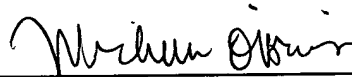
undersigned as identified 36 related co-pending applications and patents, wherein multiple Information Disclosure Statements have been filed and art has been uncovered, all of which is cited in the present application. Each reference deemed to be related most closely to the subject matter encompassed by the pending claims is listed on the Form PTO-1449 accompanying the Information Disclosure Statements or is already of record in this application.

Applicants respectfully submit that in view of the foregoing, the requirements of M.P.E.P. § 708.02 (II) have been met. Accordingly, Applicants request that this Petition to Make Special be granted and that the examination and allowance of the pending claims, as presented in the Preliminary Amendment filed herewith, be accelerated.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: February 27, 2004

By: 
Michelle E. O'Brien
Reg. No. 46,203